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Paper No.

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CLEVELAND OH 44114

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JUL 24 2009

OFFICE OF PETITIONS

In re Application of :
Boisvert et al. :
Application No. 10/765,487 : ON APPLICATION FOR
Filed: January 27, 2004 : PATENT TERM ADJUSTMENT
Atty Docket No. 14-733C2D1 :

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION UNDER 37 CFR §1.705(b) filed on March 4, 2009. Applicant submits that the correct patent term adjustment to be indicated on the patent is eight hundred ninety-eight (898) days, not four hundred thirty-four (434) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction solely on the basis that the Office will take in excess of three years to issue this patent.

The application for patent term adjustment is **GRANTED to the extent indicated.**

The Office has updated the PALM and PAIR screens to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is FOUR HUNDRED TWENTY-ONE (421) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

To the extent the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

To the extent that the instant application for patent term adjustment requests reconsideration of the PTA at the time of the mailing of the Notice of Allowance, the request is **granted to the extent indicated.**

On February 24, 2009, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicant was advised that the patent term adjustment to date was four hundred thirty-four (434) days. The period of adjustment was 434 days of PTO delay and 0 days of applicant delay.

On January 30, 2009, the subject application for patent term adjustment was timely filed.²

On June 5, 2008, a request for continued examination and an preliminary amendment were filed in response to a final office action mailed on May 30, 2009. On June 18, 2008, an information disclosure statement was filed, 13 days after the filing of the request for continued examination on June 5, 2008.³

37 CFR 1.704(c)(8) states that circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping: Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the

reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

² Office records indicate that the issue fee was paid on March 5, 2009.

³ A paper styled as an information disclosure statement (IDS) was filed with the request for continued examination on June 5, 2008. That paper was unsigned, however. On June 18, 2008, a properly signed IDS was filed.

examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

Accordingly, entry of a period of reduction of thirteen (13) days is warranted.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is four hundred twenty-one (421) days (434 days of office delay reduced by thirteen (13) days of applicant delay).

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Encl: Copy of updated PAIR screen

Day : Tuesday
Date : 7/21/2009

PALM INTRANET

Time: 19:28:06

PTA Calculations for Application: 10/765487

Application Filing Date:	01/27/2004	PTO Delay (PTO):	434
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	0
Post-Issue Petitions:	0	Total PTA (days):	421
PTO Delay Adjustment:	-13		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
86	07/21/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		13	
79	02/24/2009	MAIL NOTICE OF ALLOWANCE			
78	02/19/2009	ISSUE REVISION COMPLETED			
77	02/19/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
76	02/19/2009	CASE DOCKETED TO EXAMINER IN GAU			
75	02/19/2009	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
74	02/19/2009	DOCUMENT VERIFICATION			
73	02/19/2009	NOTICE OF ALLOWABILITY			
72	01/26/2009	DATE FORWARDED TO EXAMINER			
71	01/20/2009	AMENDMENT AFTER FINAL REJECTION			
70	01/05/2009	MAIL FINAL REJECTION (PTOL - 326)	17		65
69	01/05/2009	FINAL REJECTION			
68	10/24/2008	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
67	09/25/2008	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
66	10/06/2008	DATE FORWARDED TO EXAMINER			
65	08/19/2008	RESPONSE AFTER NON-FINAL ACTION			
63	07/23/2008	MAIL NON-FINAL REJECTION			
62	07/21/2008	NON-FINAL REJECTION			
61	06/05/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
60	06/05/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
59	06/18/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			

58	06/18/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
57	06/05/2008	REFERENCE CAPTURE ON IDS			
56	06/05/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
55	06/30/2008	DATE FORWARDED TO EXAMINER			
54	06/05/2008	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
53	06/30/2008	DATE FORWARDED TO EXAMINER			
52	06/05/2008	REQUEST FOR CONTINUED EXAMINATION (RCE)			
51	06/30/2008	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
50	06/18/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
49	06/05/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
48	06/05/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
47	06/05/2008	WORKFLOW - REQUEST FOR RCE - BEGIN			
46	05/30/2008	MAIL FINAL REJECTION (PTOL - 326)	20		43
45	05/28/2008	FINAL REJECTION			
44	02/02/2008	DATE FORWARDED TO EXAMINER			
43	01/10/2008	RESPONSE AFTER NON-FINAL ACTION			
42	10/31/2007	MAIL NON-FINAL REJECTION	11		37
41	10/26/2007	NON-FINAL REJECTION			
40	07/02/2007	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)			
39	07/02/2007	RULE 47 / 48 CORRECTION OF INVENTORSHIP PAPERS FILED			
38	06/23/2007	DATE FORWARDED TO EXAMINER			
37	06/20/2007	RESPONSE AFTER NON-FINAL ACTION			
36	05/30/2007	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
35	04/10/2007	MAIL NON-FINAL REJECTION			
34	04/02/2007	NON-FINAL REJECTION			
33	12/26/2006	DATE FORWARDED TO EXAMINER			
32	12/13/2006	RESPONSE AFTER NON-FINAL ACTION			
31	10/16/2006	MAIL NON-FINAL REJECTION	11		27
30	10/13/2006	NON-FINAL REJECTION			

29	08/02/2006	CORRESPONDENCE ADDRESS CHANGE			
28	06/09/2006	DATE FORWARDED TO EXAMINER			
27	06/05/2006	RESPONSE AFTER NON-FINAL ACTION			
26	04/06/2006	MAIL NON-FINAL REJECTION	375		-1
25	04/03/2006	NON-FINAL REJECTION			
24	11/26/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
23	12/30/2005	CORRESPONDENCE ADDRESS CHANGE			
22	12/09/2005	MAIL-RECORD PETITION DECISION OF GRANTED TO MAKE SPECIAL			
21	04/25/2005	PETITION ENTERED			
20	12/08/2005	CORRESPONDENCE ADDRESS CHANGE			
19	11/26/2004	REFERENCE CAPTURE ON IDS			
18.7	11/26/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
18	11/26/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
17	07/15/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
16	07/15/2004	CASE DOCKETED TO EXAMINER IN GAU			
15	01/27/2004	PRELIMINARY AMENDMENT			
14	06/16/2004	APPLICATION RETURN FROM OIPE			
13	06/16/2004	APPLICATION RETURN TO OIPE			
12	06/16/2004	APPLICATION RETURN FROM OIPE			
11	06/17/2004	APPLICATION IS NOW COMPLETE			
10	06/16/2004	APPLICATION RETURN TO OIPE			
9	06/15/2004	APPLICATION RETURN FROM OIPE			
8	06/16/2004	APPLICATION IS NOW COMPLETE			
7	06/15/2004	APPLICATION RETURN TO OIPE			
6	06/15/2004	APPLICATION DISPATCHED FROM OIPE			
5	06/16/2004	APPLICATION IS NOW COMPLETE			
4	03/10/2004	CLEARED BY OIPE CSR			
3	03/10/2004	CASE CLASSIFIED BY OIPE			
2	02/04/2004	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	01/27/2004	INITIAL EXAM TEAM NN			

Search Another: Application#

Search

EXPLANATION OF PTA CALCULATION